

REMARKS

Applicants respectfully request that the above application be reconsidered, as amended. Claims 1 and 16-32 are currently pending; Claim 1 has been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention.

Claim 16 has been amended to clarify that the “carrier gas” that is introduced is “inert.” Support for this amendment can be found in paragraph [0022] at page 7 of the above application. Claims 30-32 have each been amended to correct a typographical error with regard to when “heating” takes place. These amendments are without disclaimer or prejudice, and merely clarify the scope of these Claims as originally intended, and/or correct the indicated typographical errors.

A. Response to Restriction Requirement Pursuant to 35 U.S.C. § 121

At pages 2-3 of the Office Action, and pursuant to 35 U.S.C. § 121, the Examiner says that restriction to one of the following inventions is required:

- I. Claim 1, drawn to an apparatus, classified in class 118, subclass 715.
- II. Claims 16-32, drawn to a method, classified in class 427, subclass 248.1.

Referring to MPEP 806.05(e), the Examiner says that these inventions are “distinct” because: (1) Invention II (i.e., the method) can be practiced by another materially different apparatus or by hand; and (2) the apparatus (i.e., Invention I) can be used to practice another and materially different process.

As requested by the Examiner and confirming the telephone conversation of February 7, 2005, Applicants confirm their provisional election of the Invention II subject matter (i.e., the method of Claims 16-32). Applicants also respectfully request the Examiner to reconsider and withdraw this restriction requirement. Applicants submit that this restriction requirement simply exalts form impermissibly over substance. Other than referring to the different classifications for the Invention I and II subject matter, no other basis is provided for why the searches would be

different or burdensome. Accordingly, Applicants respectfully request that Inventions I and II of Claims 1 and 16-32 be examined together. See MPEP 803, which states:

“If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

B. Response to Rejection of Claims 30-32 under 35 U.S.C. § 112, Second Paragraph, for Indefiniteness

At page 2 of the Office Action, Claims 30-32 have rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. This rejection relates to a typographical error regarding what step involves “heating,” i.e., step (d) versus step (c).

Responsive to this rejection, and as suggested by the Examiner, Claims 30-32 have been amended, without disclaimer or prejudice, to correct this typographical error, and thus overcome this rejection.

C. Response to Rejection of Claims 16-17 under 35 U.S.C. § 102 as Anticipated by Pillhoefer et al

At pages 3-4 of the Office Action, Claims 16-17 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 5,455,071 (Pillhoefer et al et al).

Applicants respectfully traverse these rejections. Claims 16-17, as amended, are novel and unobvious over Pillhoefer et al for at least the following reasons:

1. The carrier gas that is introduced. Claim 16 has been amended to clarify that an inert “carrier gas” is introduced “as a plurality of carrier gas streams proximate the top of the coating container.” By contrast, Pillhoefer et al introduces a gaseous mixture of anhydrous hydrochloric or hydrofluoric acid and hydrogen through carrier gas inlet pipes 9 and 10 into the top of retort chamber 3. See col. 6, lines

5-8. This “gaseous mixture” of Pillhoefer et al cannot be considered “inert” within the meaning of Claims 16-17.

2. The path the carrier gas takes when introduced. In Claims 16-17, each carrier gas stream flows at least initially “in at least a generally centripetal path.” Claim 17 further defines each carrier gas stream as “flowing at least initially in a curved generally centripetal, downward path.” (Emphasis added). See, for example, arrows 50 of FIG. 1 from the above application that illustrate the generally centripetal downward path of these gas streams as they exit holes 30 of outlet head/manifold 18. By contrast, nowhere does Pillhoefer et al say its gas streams that exit from pipes 9 and/or 10 in FIG. 2 flow in a “generally centripetal path” according to Claim 16, much less a “curved generally centripetal, downward path” according to Claim 17. Also, and contrary to what the Office Action alleges regarding the angles of screens 4A shown in FIG. 2 of Pillhoefer et al, it is unsupported speculation as to whether the gas streams exiting screens 4A would initially move in a “generally centripetal path” according to Claim 16, and especially a “curved generally centripetal, downward path” according to Claim 17. Indeed, if the Examiner wishes to persist in the position that the gas streams of Pillhoefer et al exit screens 4A in either a “generally centripetal path” according to Claim 16, or a “curved generally centripetal, downward path” according Claim 17, Applicants respectfully request that the Examiner provide an affidavit/declaration for this belief as required by 37 CFR 1.104(d)(2) because it appears to be based on information personally known to the Examiner, and not those skilled in the art.

D. Response to Rejection of Claims 18-20 under 35 U.S.C. § 103(a) as Unpatentable over Pillhoefer et al

At pages 4-5 of the Office Action, the Examiner has rejected Claims 18-20 under 35 U.S.C. § 103(a) as unpatentable over Pillhoefer et al.

Applicants respectfully traverse this rejection for at least the same reasons why Claims 16-17 are novel and unobvious over Pillhoefer et al. Claims 18-20 are also unobvious over Pillhoefer et al for at least the following additional reason:

1. The gas flow rates for introducing the inert carrier gas. Pillhoefer et al does not teach the gas flow rates defined in Claims 18-20. Indeed, the Office Action concedes that Pillhoefer et al does not disclose these claimed gas flow rates. Instead, the Office Action alleges that Pillhoefer et al teaches the carrier gas flushes retort chamber 3, that such flow rates at which the gas is introduced would affect its flushing ability, and “hence it would have been a matter of routine experimentation to optimize this result effective parameter to values in the claim range.” However, rather than “routine experimentation,” what the Office Action alleges is simply unsupported speculation as to what Pillhoefer et al teaches. The case law relied on in the Office Action (*Ex parte Khusid*) is also inapplicable because the Pillhoefer et al does not teach any particular carrier gas flow rate, much less the gas flow rates defined in Claims 18-20. Nor would one skilled in the art have any basis for such “routine experimentation” to determine such gas flow rates, especially since Pillhoefer et al does not teach or suggest the claimed inert gas streams paths formed after the introduction of the inert carrier gas at these flow rates. Indeed, if the Examiner wishes to persist in the position that Pillhoefer teaches or suggests these claimed gas flow rates, Applicants respectfully request that the Examiner provide an affidavit/declaration for this belief as required by 37 CFR 1.104(d)(2) because it appears to be based on information personally known to the Examiner, and not those skilled in the art.

E. Response to Rejection of Claims 21-32 under 35 U.S.C. § 103(a) as Unpatentable over Pillhoefer et al in View of Walter

At pages 5-6 of the Office Action, the Examiner has rejected Claims 21-32 under 35 U.S.C. § 103(a) as unpatentable over Pillhoefer et al, in view of U.S. Patent 6,203,851 (Walter).

Applicants respectfully traverse this rejection for at least the same reasons why Claims 16-20 are novel and unobvious over Pillhoefer et al. Claims 21-32 are also unobvious over Pillhoefer et al, even in view of Walter, for at least the following additional reasons:


1. Walter supplies the propellant gas at or proximate the bottom of container 1, not the top thereof. The Office Action alleges that: (1) because Walter discloses that either hydrogen or an inert gas such as argon can be used as a propellant to be run through a metal source and deposit metallic coatings on articles in a container (referring to col. 2, lines 28-42); (2) “it would have been obvious to have included at least some inert gas such as argon in the gases of [Pillhoefer et al] during coating formation as both are suitable as propellants in vapor coating with metallic coatings in a container.” However, unlike either Claims 21-32 or even the embodiment shown in FIG. 2 of Pillhoefer et al, Walter supplies this propellant gas from the bottom of the container, not proximate the top thereof. See the gas paths illustrated in FIGs. 1-4 and 6 of Walter where the propellant gas enters container 1 at or proximate the bottom thereof from nozzle aperture 41 of Venturi nozzle 4, as well as col. 2, lines 55-57 which teaches that Venturi nozzle 4 is preferably arranged in the lower region of container 1 so that the propellant gas circulates vertically (i.e., upwardly). Accordingly, the Office Action has provided no proper basis for combining the teachings of Walter with those of Pillhoefer et al relative to Claims 21-32.
2. Walter does not supply the propellant gas as a plurality of gas streams. Unlike either Claims 21-32, or even the embodiment shown in FIG. 2 of Pillhoefer et al, the propellant gas of Walter is not supplied as a plurality of gas streams. See FIGs. 1-4 and 6 of Walter where the propellant gas appears to exit as essentially a single gas stream from nozzle aperture 41 of Venturi nozzle 4. This is yet another reason why the Office Action has provided no proper basis for combining the teachings of Walter with those of Pillhoefer et al relative to Claims 21-32.

F. Conclusion

In conclusion, the restriction requirement relative to Claims 1 and 16-32 should be withdrawn. The rejection of Claims 30-32, as amended, under 35 U.S.C. § 112, second paragraph, has been overcome. Claims 16-32, as amended, are novel and unobvious over the prior art relied in the Office Action. Accordingly, Applicants respectfully request that Claims 1 and 16-32, as amended, be allowed to issue in the above application.

Respectfully submitted,

For: Gary E. WHEAT et al

A handwritten signature in cursive script, reading "Eric W. Guttag", is written over a horizontal line.

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